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WESTERN DIGITAL TECHNOLOGIES, INC.

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EXAMINER

MCGAHEY, CHRISTOPHER S

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/982,652	<b>Applicant(s)</b> KRAPF ET AL.	
	<b>Examiner</b> CHRISTOPHER S. MCGAHEY	<b>Art Unit</b> 2421	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48, 81 and 83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48, 81 and 83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/25/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 07/25/2008 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 07/25/2008 was filed concurrently with the RCE of 09/982,652 on 07/25/2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Remark***

3. Claims 49-80, 82, and 84 have been previously cancelled. Claims 1-48, 81, and 83 are pending for reconsideration.

### ***Allowable Subject Matter***

1. The indicated allowability of claims 1-48, 81, and 83 is withdrawn in view of the newly

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discovered reference(s) to Plotnick et al. (US 2002/0178447). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6-11, 17-21, 24-28, 30-35, 41-45, 48, 81, and 83 are rejected under 35 U.S.C. 102(e) as being anticipated by Plotnick et al. (US 2002/0178447).

Regarding claim 1, Plotnick discloses “a method for displaying a targeted advertisement to a viewer of a display of an audiovisual system in conjunction with displaying a broadcast stream on the display, the method comprising:

- a. selecting a broadcast stream (¶0064, lines 5-9; ¶0070, lines 9-10);
- b. displaying the selected broadcast stream on the display (¶0063, lines 1-4);
- c. receiving a first signal from a viewer control interface indicating a viewer command to the audiovisual system (¶0091, lines 1-4; ¶0109, lines 1-3), wherein the audiovisual system is responsive to the viewer command by initiating a corresponding action selected from the group consisting of: fast-

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- forwarding the selected broadcast stream, pausing the selected broadcast stream, replaying the selected broadcast stream, and performing a program search (§0063, lines 1-4; §0109, lines 3-5, “VCR-like controls of the PVR”);
- d. defining a viewer profile of the viewer of the display based on the viewer command (§0109, lines 5-8, 12-13; §0110, lines 1-4; §0111, lines 3-5);
- e. selecting a first advertisement from a plurality of stored advertisements based on the viewer profile of the viewer of the display (§0105-107; §0112, lines 1-6); and
- f. displaying the first advertisement on the display (§0112, lines 6-8).”

As to claim 2, Plotnick discloses “the method of Claim 1, further comprising:

- g. updating the viewer profile based on a second signal received from the viewer control interface (§0110, lines 5-12);
- h. selecting a second advertisement from the plurality of stored advertisements based on the updated viewer profile (§0105-107; §0112, lines 1-6); and
- i. displaying the second advertisement on the display (§0112, lines 6-8).”

As to claim 3, Plotnick discloses “the method of Claim 2, further comprising transmitting the updated viewer profile to a head end (§0117).”

As to claim 4, Plotnick discloses “the method of claim 2, wherein step (g) comprises:

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- i. receiving a second signal from the viewer control interface indicating a viewer command to the audiovisual system, wherein the audiovisual system is responsive to the viewer command indicated by the second signal by initiating an action selected from the group consisting of: recording the first advertisement, specifying how the first advertisement is displayed on the display (¶0122, lines 9-16; ¶0123, lines 3-10), and replaying the first advertisement (emphasis added); and
- ii. updating the viewer profile based on the second signal received from the viewer control interface (¶0123, lines 3-10).”

Claims 6 and 7 essentially repeat claim 1 (e.g., "replaying the selected broadcast stream" of claim 6 and "initiating a program search" of claim 7) and are thus analyzed and rejected on the same basis at claim 1.

As to claim 8, Plotnick discloses "the method of Claim 2, wherein steps (h)-(i) are repeated until a third signal received from the viewer control interface indicates a positive viewer reaction or until a predetermined period of time has elapsed (Figure 12; ¶0124).”

As to Claim 9, Plotnick discloses "the method of Claim 1, further comprising transmitting the viewer profile to a head end (¶0117)."

As to claim 10, Plotnick discloses "the method of Claim 1, wherein step (e) comprises:

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- i. displaying an identification of at least one of the stored advertisements including the first advertisement on the display (¶0085, lines 1-8); and
- ii. receiving a second signal from the viewer control interface selecting the first advertisement to be displayed on the display (¶0085)."

As to claim 11, Plotnick discloses "the method of Claim 10, wherein step (e)(i) comprises displaying an identification of at least one of the stored advertisements including the first advertisement via a menu on the display (¶0085, particularly line 6)."

As to claim 17, Plotnick discloses "the method of claim 1, wherein the broadcast stream is a television broadcast stream (¶0070, lines 9-10)."

As to claim 18, Plotnick discloses "the method of claim 1, wherein the broadcast stream is a cable broadcast stream (¶0069, lines 1-6; ¶0073, lines 4-5)."

As to claim 19, Plotnick discloses "the method of claim 1, wherein the broadcast stream is a satellite broadcast stream (¶0069, lines 6-7; ¶0073, lines 4-6)."

As to claim 20, Plotnick discloses "the method of claim 1, wherein the broadcast stream is an Internet broadcast stream (¶0070, lines 4-6)."

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As to claim 21, Plotnick discloses “the method of Claim 1, wherein step (d) comprises defining a viewer profile of a plurality of viewers of the display based on a plurality of signals received by a controller indicating usage of a viewer control interface by the plurality of viewers (¶0110 and 0111), and step (e) comprises:

- i. determining an individual viewer profile for a viewer viewing the display at a current time (¶0112, lines 1-3); and
- ii. selecting the first advertisement from the stored advertisements based on the individual viewer profile of the viewer of the display at the current time (¶0112, lines 3-6).”

As to claim 24, Plotnick discloses “the method of Claim 1, further comprising storing the plurality of advertisements on a hard disk drive (item 136, Figure 1; ¶0066, lines 1-6; ¶0068, lines 3-8; ¶0080, lines 6-11).”

Claim 25 is identical to Claim 1 with the exception that a non-targeted ad is first displayed, followed by a targeted ad. The choice of targeted ad is made based on the viewer's response to the first non-targeted ad (e.g., fast-forwarding, pausing, replaying, or searching the ad). Plotnick clearly discloses all of these limitations (¶0123-0124; ¶0127, lines 1-5; Figure 12, where ad A1 is the non-targeted ad.).

Dependent Claims 26-28, 30-35, 41-45, and 48 are identical to dependent claims 2-4, 6-11, 17-21, and 24 with the exception that the present claims depend on independent claim 25



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rather than on independent claim 1. Given the similarity of claims 1 and 25, the present claims are analyzed and rejected on the same bases used for claims 2-4, 6-11, 17-21, and 24 above.

As to claim 81, Plotnick discloses “the method of Claim 4, wherein specifying how the first advertisement is displayed on the display comprises an action selected from the group consisting of: fast forwarding the first advertisement, displaying the first advertisement without modification, and pausing the first advertisement (¶0123, lines 3-10).” (emphasis added)

As to claim 83, Plotnick discloses “the method of Claim 28, wherein specifying how the first advertisement is displayed on the display comprises an action selected from the group consisting of: fast forwarding the first advertisement, displaying the first advertisement without modification, and pausing the first advertisement (¶0123, lines 3-10).” (emphasis added)

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (US 2002/0178447) as applied to claims 2 and 26 above, and further in view of Swix et al. (US 6,718,551).

Regarding claim 5, Plotnick discloses the method of claim 2, but does not explicitly disclose updating the viewer profiled based upon the viewer “initiating a purchase of a good/service.”

Swix teaches a system very similar to Plotnick’s. Furthermore, Swix teaches updating a viewer profile based at least in part on “services a customer has purchased or used over interactive television, such as video on demand” (Column 7, lines 52-61). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Plotnick in light of Swix’s teaching so that the viewer profile might better reflect the viewer’s preference for interactive goods and services, and so that advertisers might thus better target ads to potential customers.

As to claim 29, Plotnick discloses the method of Claim 26, but does not explicitly disclose updating the viewer profiled based upon the viewer “initiating a purchase of a good/service.” The present claim is analyzed and rejected on the same basis used for claim 5.

5. Claims 12-14 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (US 2002/0178447).

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Regarding claim 12, Plotnick discloses the method of Claim 10, but does not explicitly disclose that the ID of at least one of the stored advertisements is “a banner on the display.” Plotnick *does* disclose that the ID may be “an object in the programming or presented in a static ad (¶0085, lines 7-8).”

Official Notice is taken that a banner is a very common GUI object used to represent a file or data object. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ensure that Plotnick's "object" was a "banner" so that the viewer could have easily recognized an advertisement for selection.

As to claim 36, Plotnick discloses the method of Claim 34, but does not explicitly disclose that the ID of at least one of the stored advertisements is “a banner on the display.” The present claim is analyzed and rejected on the same basis used for claim 12.

As to claim 13, Plotnick discloses the method of Claim 10, but does not explicitly disclose that the ID of at least one of the stored advertisements is "an icon on the display." Plotnick *does* disclose that the ID may be “an object in the programming or presented in a static ad (¶0085, lines 7-8).”

Official Notice is taken that an icon is a very common GUI object used to represent a file or data object. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ensure that Plotnick's "object" was an "icon" so that the viewer could have easily recognized an advertisement for selection.

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As to claim 37, Plotnick discloses the method of Claim 34, but does not explicitly disclose that the ID of at least one of the stored advertisements is “an icon on the display.” The present claim is analyzed and rejected on the same basis used for claim 13.

As to claim 14, Plotnick discloses the method of Claim 1, but does not explicitly disclose that the first advertisement is displayed “immediately prior to displaying a second broadcast stream on the display.” Plotnick *does* disclose displaying a stored advertisement “when an ad insertion opportunity arises” (¶0112). However, Plotnick is silent as to how many ads may be shown between first and second broadcast streams.

Official Notice is taken that ad insertion schedules vary from broadcaster to broadcaster and from program to program. As an example, sporting events often have ad insertion opportunities that cannot be planned for in advance, as might occur when a sporting team calls an unexpected timeout. In these instances, there may be time for only one 30-second or 60-second ad to be displayed before rejoining the game. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ensure that Plotnick could exploit ad insertion opportunities where only one commercial time slot is provided, as might occur, for example, during sporting events.

As to claim 38, Plotnick discloses the method of Claim 25, but does not explicitly disclose that the first advertisement is displayed “immediately prior to displaying a second broadcast stream on the display.” The present claim is analyzed and rejected on the same basis used for claim 14.

6. Claims 15, 16, 22, 23, 39, 40, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (US 2002/0178447) as applied to claim 1 above, and further in view of Hite et al. (US 5,774,170).

Regarding claims 15 and 16, Plotnick discloses the method of Claim 1, but does not explicitly disclose either (a) displaying the targeted advertisement in a time slot adjacent to the time slot for a regularly scheduled ad (claim 15) or (b) displaying the targeted ad in place of a regularly scheduled ad (claim 16).

Hite teaches a broadcast stream that has both preemptable and non-preemptable commercials (Column 7, line 64 – Column 8, line 17). Thus, when a preemptable time slot is adjacent to a non-preemptable time slot, situation (a) results. When a single preemptable time slot is present, situation (b) results. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ensure that Plotnick's system included both preemptable and non-preemptable commercial time slots a la Hite. This would have been done so that advertisers could use non-preemptable commercials to reach all viewers, regardless of their personal viewing preferences.

As to claims 39 and 40, Plotnick discloses the method of Claim 25, but does not explicitly disclose either (a) displaying the targeted advertisement in a time slot adjacent to the time slot for a regularly scheduled ad (claim 15) or (b) displaying the targeted ad in place of a

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regularly scheduled ad (claim 16). The present claims are analyzed and rejected on the same basis used for claims 15 and 16.

As to claim 22, Plotnick discloses the method of Claim 21, but neither explicitly discloses nor precludes the further claimed limitation “wherein step (e)(ii) comprises selecting the first advertisement from the stored advertisements based on the individual viewer profile of the viewer of the display at the current time and based on content of the selected broadcast stream.” (emphasis added)

Hite teaches transmitting a special code along with certain broadcast programs to ensure that inappropriate commercials are not displayed during these programs (Column 6, lines 52-59; Column 7, lines 31-33, "context"). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Plotnick in light of Hite's teaching so that broadcasters could retain some degree of control over what types of advertisements are displayed during broadcast programs.

As to claim 46, Plotnick discloses the method of Claim 45, but neither explicitly discloses nor precludes the further claimed limitation “wherein step (e)(ii) comprises selecting the first advertisement from the stored advertisements based on the individual viewer profile of the viewer of the display at the current time and based on content of the selected broadcast stream.” (emphasis added) The present claim is analyzed and rejected on the same basis used for claim 22.

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Claims 23 and 47, like claims 22 and 46, involve basing an advertisement selection on both a viewer profile and the content of the selected broadcast stream. Thus, the present claims are analyzed and rejected on the same basis used for claims 22 and 46.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Grauch et al. (US 6,983,478) teaches a method for monitoring and recording all user interactions with an interactive media system, including "trick play" commands such as fast-forward, reverse, and pause. Schlack et al. (US 7,260,823) teaches a method of creating and maintaining user profiles based on monitored user behavior.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER S. MCGAHEY whose telephone number is (571)270-5670. The examiner can normally be reached on Monday-Friday, 7:30am-5:00pm; alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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